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10/608,718

06/27/2003

Richard D. Emery

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05/23/2008

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EXAMINER

NGUYEN, DILINH P

ART UNIT

PAPER NUMBER

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD D. EMERY

Appeal 2008-0778
Application 10/608,718
Technology Center 2800

Decided: May 23, 2008

Before CHARLES F. WARREN, PETER F. KRATZ, and
MICHAEL P. COLAIANNI, *Administrative Patent Judges*.
KRATZ, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

This remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) (2007) is made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

The appeal is not ripe for review as a result of inconsistencies or incompleteness in the appeal record as to the rejections before us, the evidence relied upon, and the status of claim amendments presented.

In this regard, the Non-Final Office Action of May 31, 2006 from which this appeal is taken includes, *inter alia*, (1) a rejection of appealed claims 1 and 6 under 35 U.S.C. § 102(b) over Horvath (U.S. Patent No. 4,415,025); (2) a rejection of appealed claims 1, 4, and 6 under 35 U.S.C. § 102(b) over Lee et al. (U.S. Patent No. 6,081,037); (3) a rejection of appealed claims 1 and 6 under 35 U.S.C. § 102(e) over Turner (U.S. Patent Appl. Pub. No. 2002/0185728); and (4) a rejection of appealed claims 3 and 7-10 under 35 U.S.C. § 103(a) over Horvath, Lee et al. or Turner, each taken in view of Zhang et al. (U.S. Patent Appl. Pub. No. 2002/0171144) (Off. Act. 2-5).

However, in the Examiner's Answer, the Examiner does not list Turner as evidence being relied upon and does not present Rejection (3) above. Nevertheless, the Examiner inconsistently presents a rejoinder to Appellants' arguments respecting Rejection (3) in the Examiner's Answer (Ans. 8-9). Also, Rejection (4) is presented without Turner being listed as part of the evidence used in rejecting the appealed claims identified in that rejection. Yet, the Examiner indicates agreement with Appellant's listing of the grounds of rejection to be reviewed on appeal as set forth in the Appeal Brief, which listing includes Turner as part of the evidence relied upon by the Examiner in Rejection (4) (Ans. 2; Br. 8). On this record, we decline to speculate as to the references and rejections that are maintained by the Examiner.

Also, an Amendment to claims 4 and 31 was filed on November 3, 2006, after the Notice of Appeal was filed. This amendment is mentioned in the "Statement of Amendments" section of the Appeal Brief (5). The Examiner, however, does not explicitly identify the entry status of the amendment in the Answer or in another Paper filed in response thereto.

Consequently, the appeal record requires clarification with regard to the entry status of the claim amendments presented, the grounds of rejection maintained by the Examiner, and the references being relied upon.

In light of the foregoing, we remand this application to the Examiner to identify all of the references being relied on in rejecting the appealed claims, as well as, identifying and reproducing the statements of rejection being relied upon. In so doing, the Examiner must clarify the application file record to consistently and unambiguously specify which references are being applied in the rejection of each of the appealed claims with regard to any rejections that are maintained in responding to this remand. References not being relied upon in rejecting a claim should not be discussed in explaining the rejection of that claim. Moreover, the entry status of the Amendment filed November 03, 2006 should be clarified.

ORDER

We remand this appealed application to the jurisdiction of the Examiner for action not inconsistent with our comments made above.

37 C.F.R. § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this Remand.

This application requires immediate action by the Examiner. The Board of Patent Appeals and Interferences should be informed promptly of

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any action affecting the appeal in this case, including reopening of prosecution, allowance and/or abandonment of the application.

REMANDED

tc

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